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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/648,816

08/25/2000

Michael R. Yeaman

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MCDERMOTT, WILL & EMERY  
11682 EL CAMINO REAL  
SUITE 400  
SAN DIEGO, CA 92130-2047

EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1656

NOTIFICATION DATE

DELIVERY MODE

05/14/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SIP\_Docket@mwe.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/648,816	<b>Applicant(s)</b> YEAMAN ET AL.	
	<b>Examiner</b> CHIH-MIN KAM	<b>Art Unit</b> 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-83 and 85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-69, 76 and 79 is/are rejected.
- 7) ☒ Claim(s) 70-75, 77, 78, 80-83 and 85 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 67-83 and 85 are pending.

Applicants' amendment filed on December 28, 2009 is acknowledged. Applicants' response has been fully considered. Claim 67 has been amended. Therefore, claims 67-83 and 85 are examined.

### **Withdrawn Claim Objections**

2. The previous objection to claim 67 is withdrawn in view of applicants' amendment to the claim, and applicants' response at page 4 of the amendment filed December 28, 2009.

### ***Maintained Claim Rejections-Obviousness Type Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 67-69, 76 and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U. S. Patent 6,743,769. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 67-69, 76 and 79 in the instant application disclose an isolated antimicrobial peptide consisting of an amino acid sequence of 13-74 amino acids with a 7 amino acid core sequence:

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aa1-aa2-aa3-aa4-aa5-aa6-aa7, where amino acid residue at each position is defined, and a modified antimicrobial peptide with the amino acids in the 7 amino acid core sequence modified and retaining antimicrobial activity, wherein the modified amino acids are selected from the group consisting of N-epsilon-monomethyl lysine, beta branched amino acids, N-methylamino acids, alpha, beta-dehydro amino acids, and fluorinated amino acids; and an antimicrobial peptide comprising the sequence of SEQ ID NO:3, 10 or 13. This is obvious variation in view of claim 1 of the patent which discloses an antimicrobial peptide comprising the amino acid sequence of SEQ ID NO:3, 10, 13 or 14. Both sets of claims cite an antimicrobial peptide comprising the amino acid sequence of SEQ ID NO:3, 10 or 13. Thus, claims 67-69, 76 and 79 in the present application and claim 1 in the patent are obvious variations of an antimicrobial peptide comprising the amino acid sequence of SEQ ID NO:3, 10 or 13.

4. Claims 67-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U. S. Patent 7,067,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 67-69 in the instant application disclose an isolated antimicrobial peptide consisting of an amino acid sequence of 13-74 amino acids with a 7 amino acid core sequence: aa1-aa2-aa3-aa4-aa5-aa6-aa7, where amino acid residue at each position is defined, and a modified antimicrobial peptide with the amino acids of the 7 amino acid core sequence modified and retaining antimicrobial activity; and an antimicrobial peptide comprising SEQ ID NO:3. This is obvious variation in view of claims 1-8 of the patent which disclose a context-activating peptide comprising the amino acid sequence of SEQ ID NO:1, 2, 3 or 4, which contains the core sequence of Ala-Leu-Tyr-Lys-Lys-Phe-Lys, where SEQ ID NO:1 (33 amino acids), 2 (36 amino

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acids) and 4 (39 amino acids) of the patent comprises the instant sequence of SEQ ID NO:3 (18 amino acids) and the specification indicates SEQ ID NO:1, 2, 3, or 4 has less anti-microbial activity than the anti-microbial peptide, RP-1 (column 4, line 50-column 5, line 56). Both sets of claims cite an antimicrobial peptide comprising the core sequence of Ala-Leu-Tyr-Lys-Lys-Phe-Lys or the instant SEQ ID NO:3. Thus, claims 67-69 in present application and claims 1-8 in the patent are obvious variations of an antimicrobial peptide comprising the amino acid core sequence of Ala-Leu-Tyr-Lys-Lys-Phe-Lys or the instant SEQ ID NO:3.

#### *Response to Arguments*

Applicants indicate they have submitted terminal disclaimers to the '769 and '621 patents, and request withdrawal of the rejections (page 4 of the response).

Although applicants have submitted terminal disclaimers, these terminal disclaimers were disapproved because in the terminal disclaimer, "commonly owned" is need after enforceable clause, the words "legal title" do not include common ownership as to equitable title, see 37 CFR 1.321(c)(3). Therefore, the rejection is maintained.

#### ***Claim Objections***

5. Claims 70-75, 77, 78, 80-83 and 85 are objected to because the claims are dependent from a rejected claim.

***Conclusion***

6. Claims 67-69, 76 and 79 are rejected; and claims 70-75, 77, 78, 80-83 and 85 are objected to.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached at 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Chih-Min Kam/

Primary Examiner, Art Unit 1656

CMK

May 10, 2010